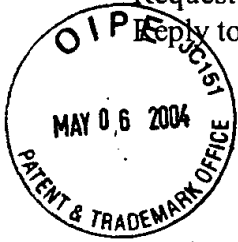


AF 3732

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Appln. No. 10/007,812
Request for Reconsideration dated May 4, 2004
Reply to Office Action of February 23, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. : 10/007,812
Applicant : ROBERT S. SUPINSKI
Filed : November 8, 2001
Title : PATELLA REPLACEMENT APPARATUS

Group Art Unit : 3732
Examiner : David A. Bonderer

Docket No. : 011072

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on

this 4th day of May, 2004

Buchanan Ingersoll, P.C.
Buchanan Ingersoll, P.C.

REQUEST FOR RECONSIDERATION

Pittsburgh, Pennsylvania 15219

May 4, 2004

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

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The Examiner has rejected all the pending claims as anticipated or obvious from United States Patent No. 6,146,423 issued November 14, 2000, to Cohen et al. based on an application filed January 28, 1999. Submitted herewith is a Declaration of C. Brain McDaniel which demonstrates that applicant conceived and actually reduced to practice the patella device of claim 22 at least as early as May, 1990.

In response to the previous Office Action applicant submitted a Declaration of the inventor, Dr. Robert Supinski, which alleged conception in 1989 and actual reduction to practice on March 15, 1990. The Examiner determined that the evidence submitted was insufficient to

establish conception prior to the effective date of the Cohen reference because the earliest drawings showing the projection from one member which coated with an aperture in the second member was Exhibit 5-E dated January 26, 2001. The Declaration of C. Brian McDaniel and drawings attached to that Declaration show a replacement patella device made for applicant, Dr. Supinski, which has a projection on one member that coats with an aperture on the second member. That drawing is dated March 23, 1990. Mr. McDaniel says that he knows the product was actually made by April 13, 1990, and that nine similar devices were made prior to June, 1999. He further states that he understood from Dr. Supinski that either part could be metal as long as the other part was plastic. Applicant therefore submits that this evidence clearly shows conception and an actual reduction to practice well before the effective date of the Cohen reference.

Although claims 1-21 of the present application are identical to claims in the Cohen reference, pending claim 22 is significantly different from those claims. Claim 22 requires a porous coating containing a bone growth material on either the first member or the second member. No such coating is disclosed or claimed by Cohen. All the claims of Cohen require that the member containing the apertures be metal. There is no such requirement in claim 22. For these reasons, claim 22 is not only allowable, but is also patentably distinct over the claims of Cohen.

In paragraph 1 of the Office Action the Examiner states that applicant failed to identify the patent number and number of claims copied from the Cohen reference as required by 37 C.F.R. 1.607(c). That is not true, in the last paragraph of the Request for Consideration applicant identified those claims saying, "Claims 1-21 of the present application were copied from claims

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1-13, 15-17, 19-22 and 24 of the cited Cohen patent. Applicant believed that this identification in the Request for Reconsideration complies with the requirement of 37 C.F.R. 1.607(c).

The Examiner also cited Chapter 2300 of the MPEP for information on initiating interference proceedings. Applicant submits that the information provided in the Request for Reconsideration filed January 7, 2004, provides all of the information required for initiation of an interference. Nevertheless, submitted herewith is a separate Request for Declaration of Interference with United States Patent No. 6,146,423.

Reconsideration, allowance and declaration of an interference with U.S. Patent No. 6,146,423 are respectfully requested.

Respectfully submitted,



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